



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/796,718

03/08/2004

Patrice M. Fabre

027385-000200US

1798

20350 7590 10/20/2009

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

RICEK, JASON D

ART UNIT

PAPER NUMBER

2442

MAIL DATE

DELIVERY MODE

10/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,718

Applicant(s)

FABRE ET AL.

Examiner

JASON RECEK

Art Unit

2442

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 100)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This is in response to the amendment filed on June 15th 2009.

Status of Claims

Claims 1-23 and 25-26 are pending but currently rejected under 35 U.S.C. 103(a).

Response to Arguments

1. Applicant's arguments, see pg. 9-11, filed 6/12/09, with respect to claims 1-23, 25-25 have been fully considered and are persuasive. Therefore the rejection has been withdrawn. However, upon further consideration a new rejection is made in view of Du US 7,231,427 B1.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Du US 7,231,427 B1 in view of Knox et al. US2007/0005762 A1.

Regarding claim 1, Du discloses "an internal e-mail facility ... for facilitating and tracking e-mail communications between (i) an end user ... and (ii) an external contact" as a mail server that operates between subscribers and non-subscribers (abstract, Fig. 1),

"sending an initial e-mail from said internal e-mail facility to the external contact, wherein a domain of a REPLY-TO field ... corresponds to a domain of said internal e-mail facility" (reply field of Fig. 1 contains domain of mail server), "a local part of said REPLY-TO field of said initial email message comprises a tracking string ... associated with said end user" a portion of the reply field is changed in order to conceal the email address and is also used to archive (i.e. track) the email (Figs. 1-2, 6, col. 2 ln. 8-18, col. 3 ln. 1-13),

"receiving at said internal e-mail facility a first reply e-mail message from said external contact" (col. 2 ln. 53-58), "having a TO field including said tracking string" email is addressed to the server having the address inserted by the server which includes the data for tracking (col. 2 ln. 46-59),

"sending from said internal e-mail facility a modified version of said first reply e-mail message to a native e-mail address of the end user" intermediate server modifies email and forwards to native address (col. 2 ln. 60-64), "a domain of a REPLY-TO field of said modified version ... corresponds to said domain of said internal e-mail facility"

system changes reply-to address (col. 2 ln. 63-64), and "a local part of said REPLY-TO field comprises a first modified version of said tracking string" reply-to field is modified (col. 2 ln. 63-67), the intermediate server uses this portion of the reply field to archive emails (col. 3 ln. 11-13), which allows the user to track an email conversation (col. 3 ln. 14-15).

Du does not explicitly disclose "a tracking string encoding tracking information" rather the information contained in the reply-to fields of Du is used for privacy and archiving the emails (Fig. 6, col. 3 ln. 11-13). However, Knox explicitly teaches inserting a tracking code into an email (paragraphs 6-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Du such that the tracking string contained tracking information as disclosed by Knox for the purpose of monitoring email. Du already teaches inserting a string in the reply-to field for archiving email conversations between a sender and receiver. Knox further suggests it is desirable to monitor the behavior of an email recipient (paragraph 4).

Regarding claim 2, Du discloses "archiving said first reply e-mail message" (col. 5 ln. 9-22).

Du does not explicitly disclose "generating a first metadata object based on said tracking string" or "metadata object associates [...] said end user, said external contact, and at least one business functionality", however this is taught by Knox as generating a

cookie based on tracking information (paragraph 20), and associating who sent the email, the recipient and the behavior (business information) of the recipient (paragraph 26). Motivation to combine is the same as that given above.

Regarding claim 3, Du does not explicitly disclose "generating a viewable communication log screen including information derived from said first metadata object" however this is taught by Knox as displaying information from the metadata object to a user (paragraphs 40-41).

Regarding claim 4, Du discloses "second reply e-mail message having a TO field including said first modified version of said tracking string" when the original sender replies to the reply the process will repeat and the TO-field will contain the modified tracking string because when a user replies the contents of the reply-to field are copied to the to field (col. 4 ln. 5-30), and

"sending a modified version of said second reply e-mail message to the external contact, wherein a domain of a REPLY-TO field of said modified version of said second reply e-mail message corresponds to said domain of said internal e-mail facility, and wherein a local part of said REPLY-TO field comprises a second modified version of said tracking string" reply-to and to field contain domain of e-mail facility and tracking strings inserted by intermediate server (Figs. 1-2).

Regarding claim 5, it corresponds to claim 2 but recites a second iteration. Therefore it is rejected for similar reasons.

Knox discloses “generating a second metadata object based on said second modified version of said tracking string” as generating a secondary cookie (paragraph 32) which performs the same functions as the first such as: “associates said second reply e-mail message with said end user, said external contact, and said at least one business functionality” (paragraph 26).

Regarding claim 6, Du does not explicitly disclose “generating a viewable communication log screen including information derived from said first metadata object and said second metadata object” however this is taught by Knox as displaying information from the metadata objects to a user (paragraphs 40-41, 43).

Regarding claim 7, Du does not explicitly disclose “native e-mail system of said end user is a web-hosted e-mail service” however this is taught by Knox as a web-based email (paragraph 15).

Regarding claim 8, Du does not explicitly disclose “native e-mail system of said end user is a dedicated desktop e-mail application” however this is taught by Knox as a application email program (paragraph 15).

Regarding claim 9, Du does not explicitly disclose "internal e-mail facility is operated out of a same Internet domain as said web-based business information system" however this is taught by Knox as a user sending email from his business association which is associated with a single domain (paragraph 15).

Regarding claim 10, Du does not explicitly disclose "initial e-mail message comprises a message body manually composed by the end user" however this is taught by Knox as a user composing an email (paragraph 15).

Regarding claim 11, Du discloses "initial e-mail message is automatically sent on behalf of the end user by said web-based business information system" as a server which sends an email (col. 2 ln. 44-45).

Regarding claim 12, Du discloses "REPLY-TO field of said initial e-mail message further comprises a display name for said end user that is substantially identical to a display name associated with said end user in said native e-mail system" (Fig. 1).

Regarding claim 13, Du discloses "subscribed to by a business enterprise" as users subscribe (col. 2 ln. 8-11). Knox also discloses "web-based business information system is provided by an application service provider and subscribed to by a business enterprise" as a business user whose email is provided by a service provider such as Yahoo (paragraph 15).

Regarding claim 14, Du does not explicitly disclose “web-based business information system is self-hosted by a business enterprise” however this is taught by Knox as a business which owns the domain and thus the email system is ‘self-hosted’ (paragraph 15).

Regarding claim 15, it is identical to claim 1 with the exception of “reply-to” replaced with “reply-designating header” in light of Applicant’s specification (paragraph 76), Applicant’s claim 18 and Applicant Admitted Prior Art RFC 2822 pg. 21 the term “reply-designating header” is broader than the term “reply-to” and thus claim 15 is rejected for the same reasons as claim 1.

Regarding claims 16-17, they correspond to claims 2 and 4 respectively and therefore are rejected for similar reasons.

Regarding claim 18, the limitation “reply designating header fields [...] are each REPLY-TO fields” makes claim 18 correspond in scope to claim 4, and is therefore rejected for similar reasons.

Regarding claim 19, Du discloses “reply designating header fields [...] are each FROM fields” as from addressing (col. 2 In. 11).

Regarding claim 20, it is similar to claims 1 and 15 and those similar parts are rejected for the same reasons given in the rejection of claims 1 and 15. Claim 20 adds the limitations "first thread-recurrent field of said initial e-mail message comprises a tracking string" and "a second thread-recurrent field" that comprises a "first modified version of said tracking string". Thread recurrent fields are disclosed by Knox as subject fields of an email (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Du and Knox by adding a tracking string to a subject field of an email. That technique is well known in the art and yields predictable results.

Regarding claim 21, it is identical to claim 2 and is therefore rejected for the same reasons.

Regarding claim 22, it is substantially similar to claim 4 and the similar parts are thus rejected for the same reasons. Claim 22 adds the limitation "thread-recurrent field". As discussed in the rejection of claim 20 Knox discloses thread recurrent fields (Fig. 2).

Regarding claim 23, it is identical to claim 18 and is therefore rejected for the same reasons.

Regarding claim 25, Knox discloses "said first, second, and third thread-recurrent fields are each SUBJECT fields" as subject fields in an email (Fig. 2). As discussed in claim 20, it is well known to place tracking information in a subject field of an email.

3. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Du and Knox in view of Bargagli Damm et al. US 2004/0006598 A1.

Regarding claim 26, the combination of Du and Knox does not disclose "said first, second and third thread-recurrent fields are encrypted into body fields of said initial e-mail message" however encryption of email objects is taught by Bargagli Damm (paragraph 98) including encryption of an email header (paragraph 105).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Du and Knox by adding encryption taught by Bargagli Damm for the purpose of security. Encryption is well known in the art and provides predictable results.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nassiri US 2002/0046250 A1 discloses a system that tracks email to verify sending an delivery (abstract).

Levosky US 7,054,906 B2 discloses an email server that generates alias email addresses for communicating, the server also stores, forwards and logs the emails using the alias and other user information (abstract).

Gabber et al. US 6,591,291 B1 discloses an email remailing service (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Fri 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached 4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Recek/
Examiner, Art Unit 2442
(571) 270-1975
/saleh najjar/
Supervisory Patent Examiner, Art Unit 2455